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OPPOSER'S REPLY BRIEF

INTRODUCTION

This case involves confusingly similar marks – J&M in both script and block forms, and GM in a script that looks like “JM” - for identical and closely related goods, which may be sold through the same trade channels to the same customers. There is no issue of priority. Genesco Brands, Inc. and its predecessors and licensees (“Genesco”)¹ have continuously used the J&M Mark since at least as early as April 21, 1892 – over 107 years prior to the filing date of Gregory Martz’s (“Martz”) federal registration application. Additionally, Genesco owns at least seven incontestable federal registrations for marks comprised of the formative J&M, including two covering the stylized script mark.

In Applicant’s Trial Brief (“App. Tr. Br.”), Martz argues that the marks are different and that “a G is not a J.” Applicant also argues, for the first time, that the Testimony Deposition of Jason Dasal should be excluded. As discussed below, this contention is untimely and without merit.

ARGUMENT

I. Martz’s Contention That There is No Likelihood of Confusion is Erroneous.

A. Applicant’s Mark Easily Could Be Perceived as “JM.”

Martz argues that “there is no legal authority to support Opposer’s position” because Opposer’s Trial Brief “did not cite one case dealing with initials.” App. Tr. Br. p. 3. This argument is irrelevant because marks consisting of initials are subject to the same principles

¹ Genesco Brands Inc. is a wholly owned subsidiary of Genesco Inc., and the owner by assignment recorded with the U.S. Patent and Trademark Office on September 4, 2001 at reel 2365/frame 0925 of all of the trademarks formerly owned by Genesco Inc. All of the J&M Marks, on which this opposition is based, are exclusively licensed to Genesco Inc.

of likelihood of confusion as all other marks. As the Board has stated: “It appears to be well established that letter marks are entitled to the same scope of protection as other registered marks in precluding registration of the same or confusingly similar marks for related goods.” In re Standard Kollsman Indus., Inc., 156 U.S. P.Q. 346, 347 (T.T.A.B. 1967) (affirming refusal to register the mark SKI for “television tuners” based on prior registrations of the marks SK-97, SK-128, SK-98, and SK-58 for “coaxial high fidelity speakers for radios and phonographs” under Section 2(d) of Lanham Act); see also J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 7:9 – 7:11. (“Like any other symbol, an individual letter or a group of letters, not forming a recognizable word, can function as a mark.”). In fact, the Board “[m]ust also consider the well-established principle of our trademark law that confusion is more likely between arbitrarily arranged letters than between other types of marks.” Edison Bros. Stores, Inc. v. Brutting E.B. Sport-Inter. GmbH, 230 U.S.P.Q. 530, 532-33 (T.T.A.B. 1986) (refusing registration of the mark EB based on likelihood of confusion with the mark EBS). See also Weiss Assoc., Inc. v. HRL Assoc., Inc., 14 U.S.P.Q.2d 1840, 1842 (Fed. Cir. 1990) (affirming refusal of registration of the mark TMM based on likelihood of confusingly with the mark TMS); Cluett, Peabody & Co., Inc. v. J.H. Bonck Co., Inc., 156 U.S.P.Q. 401 (C.C.P.A. 1968) (affirming refusal to register the mark TTM based on prior registration of the mark T.M.T.).

In the present case, there is nothing to inform the consumer that Martz’s stylized script mark is intended to represent the letter “G” rather than “J.” The stylized letter consists of two open loops closely similar to the “J” of Genesco’s script design mark. Further, contrary to Martz’s contention, the thumbprint background design and additional words, in

partially obscured, small lettering, are insufficient to alter the commercial impression created by the dominant script letters, which can easily be read as “JM.”

B. The Similarity of Goods and Overlapping Trade Channels Are Important Considerations in the Likelihood of Confusion Analysis.

At page 3 of Applicant’s Trial Brief, Martz argues “[I]t makes no difference that Martz and Opposer may use their respective marks on the same or similar goods in the same channels of commerce.” Not only does this statement suggest a concession by Martz that the parties’ respective goods and trade channels are similar, but it also directly contradicts well established principles of trademark law. In particular, the second and third DuPont factors, which are applied in determining whether a likelihood of confusion exists, are the similarity of the parties’ respective goods and trade channels.² As set forth in Opposer’s Trial Brief, numerous Board decisions support Genesco’s contention that the identical and closely related nature of the parties’ goods and the overlap of trade channels demonstrate a likelihood of confusion between Genesco’s J&M Marks and Martz’s mark.³ Therefore, Martz’s dismissal of these factors is erroneous.

² “In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered: ... (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is used. (3) The similarity or dissimilarity of established, likely-to-continue trade channels.” DuPont, 476 F.2d 1361, 177 U.S.P.Q. at 567.

³ See also In re Thomas H. Wilson, 57 U.S.P.Q.2d 1863, 1867 (T.T.A.B. 2001) (affirms refusal to register the mark PINE CONE BRAND and Design for containers of various types of fresh fruit based on prior registration for PINE CONE for “canned peaches, apples, stringless beans, lima beans, corn, sweet potatoes, tomatoes, and tomato products”)(similarity of goods and overlapping trade channels both considered in determining likelihood of confusion).

C. The Appropriate Standard is Likelihood of Confusion, Not Actual Confusion.

Martz also contends that Genesco has not presented any evidence of actual confusion and “[o]pposer has admitted that it is not aware of any actual confusion.” App. Tr. Br. at 3. However, Genesco only is required to show a likelihood of confusion. “[T]he lack of any occurrences of actual confusion is not dispositive inasmuch as evidence thereof is notoriously difficult to come by and, in any event, the test under Section 2(d) of the Trademark Act is likelihood of confusion rather than actual confusion.” Gillette Canada Inc. v. Ranir Corp., 23 U.S.P.Q.2d 1768, 1788 (T.T.A.B. 1992) (sustaining the opposition to and refusing registration of the mark ORAL-ANGLE for toothbrushes based on a likelihood of confusion with the mark ORAL-B for dentistry products).⁴ Further, Martz’s testimony indicates that his mark has not yet been widely used for apparel (Martz Test. Dep. pp. 21-24), although he has ambitions to create a major brand (Id. pp. 25-26). Therefore, the opportunity for actual confusion to arise has been limited so far.

D. The Fame of Genesco’s J&M Marks is a Relevant Factor in the Likelihood of Confusion Analysis.

Martz’s final argument on the merits of this opposition is that the fame of Genesco’s J&M Marks is not significant to the Board’s analysis. Martz argues that:

The fact that there is only one shared letter is not enough to create a likelihood of confusion. No amount of fame can turn a “g” into a “J.”

⁴ See also Weiss Assoc., 14 U.S.P.Q.2d at 1843 (“Before this Court, the test is likelihood of confusion not actual confusion. It is unnecessary to show actual confusion in establishing likelihood of confusion.”); MSI Data Corp. v. Microprocessor Sys., Inc., 220 U.S.P.Q. 655, 668 (T.T.A.B. 1983) (sustaining the opposition to and refusing registration of the mark MSI (stylized) and design for computer hardware manufacturing services based on a likelihood of confusion with the mark MSI (stylized) for electronic ordering systems for gathering and transmitting source data)(“[A]ctual confusion need not be proved to find likelihood of confusion under Section 2(d)”)(emphasis added).

App. Tr. Br. p. 4. It could be equally stated that no amount of calling Martz's stylized mark "GM" can change the fact that it resembles "JM."

Contrary to Martz's argument, the fame of a prior mark is one of the factors for the Board to consider in the likelihood of confusion analysis.⁵ During Genesco's ninety-one years of prior use of the J&M Marks,⁶ Genesco has accrued a high degree of fame and goodwill in the J&M Marks, which should be considered by the Board in the likelihood of confusion analysis. See Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992) ("The fifth *DuPont* factor, fame of the prior mark, plays a dominant role in cases featuring a famous or strong mark. Famous or strong marks enjoy a wide latitude of legal protection."). The public's high degree of familiarity with famous marks creates a predisposition to recognize similar marks as identifying the same source by triggering instant recognition as discussed in detail in Opposer's Trial Brief. The fame of Genesco's mark weighs heavily in Genesco's favor.

Genesco does not argue that "one shared letter" constitutes a likelihood of confusion; but that both letters in combination would be perceived as being the same as Genesco's marks. The visual similarity of the marks, identical and closely related nature of the goods, trade channels and customers, in addition to the fame of the J&M Marks, all demonstrate a likelihood of confusion in this case.

⁵ The fifth DuPont factor is "the fame of the prior mark (sales, advertising, length of use)." DuPont, 476 F.2d 1361, 177 U.S.P.Q. 567.

⁶ Genesco's first use date of the J&M Marks is April 21, 1892 (Dasal Test. Dep. p. 11), Martz's first use date of his mark is June 1983.

II. Martz's Request To Exclude the Testimony Deposition of Jason Dasal Is Without Merit.

At the eleventh hour of this opposition, Martz's Trial Brief objects to and requests that the testimony deposition of Jason Dasal ("Dasal Test.") be excluded. See App. Tr. Br. at 4. During the testimony deposition, a dispute arose between the parties regarding whether Martz's counsel was entitled to review notes that Mr. Dasal referred to during his deposition. Dasal Test. pp. 32-34. Genesco's counsel expressed the view that the notes were privileged but invited Martz's counsel to raise the issue with the Board if he believed he was entitled to see the notes:

Ms. Taylor: Well, we don't agree on that point, and you certainly can present that argument to the Board...

Dasal Test. pp. 33-34. Martz did not file a motion to require production of the notes or any other motion with the Board regarding this issue at any time following the date of Mr. Dasal's testimony deposition (November 1, 2001) prior to the submission of Applicant's Trial Brief.

Objections to the testimony deposition, such as the ones raised by Martz in Applicant's Trial Brief, should have been raised with the Board after the completion of the testimony deposition. The TBMP provides with regard to objections made during a testimony deposition:

Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances.

Trademark Trial and Appeal Board Manual of Procedure § 718.03(c). In the present case, Martz's counsel did not object on the record to Mr. Dasal's testimony, but only demanded production of the notes. It is elementary that: "a party may waive an objection to evidence

by failing to raise the objection at the appropriate time.” TBMP, citing 37 CFR §§ 2.123(e)(3), 2.123(j), and 2.123(k); Federal Rule of Civil Procedure 32(d)(1), (2), and (3)(A) and B; and TBMP §§ 718.02 and 718.03.

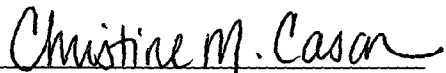
If Martz’s counsel believed he was entitled to the requested document he should have raised this issue with the Board by filing an appropriate motion promptly after the conclusion of the testimony deposition of Mr. Dasal. By failing to do so, he seeks to strike that testimony without affording Genesco the opportunity to have the Board rule on the evidentiary issue of whether the notes must be produced and, if the Board ruled in Martz’s favor, to produce these notes to Martz and make Mr. Dasal available for further cross examination regarding the notes. It is too late to remedy any lost opportunity for further cross examination at this stage. There is absolutely no authority for the drastic request to strike all of opposer’s testimony as a remedy for such an unresolved evidentiary dispute. Having failed to seek an evidentiary ruling by the Board at the proper time promptly following Mr. Dasal’s deposition, Martz should not be permitted – during trial – to request that the entire testimony deposition of Jason Dasal be excluded.

III. Conclusion

Genesco will be damaged if Martz’s federal registration application for the GM Mark registers on the Principal Register. Genesco has shown that a likelihood of confusion exists between the parties’ marks based on: (1) the confusingly similar appearance of the parties marks; (2) the identical and closely related goods for which the marks of the parties are used or proposed to be used in connection with the parties’ respective marks; (3) the overlapping trade channels; and (4) the strength and fame of Genesco’s J&M Marks.

Accordingly, the Board should sustain this Opposition and refuse registration of Applicant's Mark (Serial No. 75/707,767).

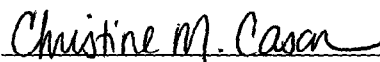
Respectfully submitted:


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Genesco Brands Inc., as successor of
Genesco Inc.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents and Trademarks, TTAB NO FEE 2900 Crystal Drive, Arlington, Virginia 22202 on May 30, 2002.


Christine M. Cason
Date: May 30, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

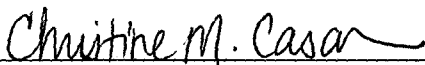
GENESCO BRANDS INC., AS)	
SUCCESSOR OF GENESCO INC.,)	
)	
Opposer,)	Serial No. 75/707,767
)	Opposition No. 121,296
v.)	
)	
GREGORY MARTZ,)	
)	
Applicant.)	

CERTIFICATE OF SERVICE

This is to certify that I have this day served a true and correct copy of the foregoing
OPPOSER'S REPLY BRIEF on counsel for Applicant by depositing a copy thereof by first
class mail, postage prepaid, and addressed as follows:

Douglas M. Vickery, Esq.
Emerald Plaza
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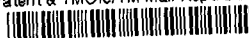
This 30th day of May, 2002.


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May 30, 2002

VIA U. S. MAIL

Assistant Commissioner for Trademarks
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Arlington, Virginia 22202-3514

Re: Applicant: Gregory Martz
Opposer: Genesco Brands Inc., as
Successor of Genesco Inc.
Opposition No.: 121,296
Serial No.: 75/707,767
Our Ref. No.: G2120/205339

02 JUN -6 PM 8:23
TRADEMARK TRIAL AND
APPEAL BOARD

Dear Sir or Madam:

Enclosed please find three copies of Opposer's Reply Brief in the above-referenced matter.

Please acknowledge receipt of the enclosure by initialing and dating the enclosed postcard and returning it to me.

Thank you for your assistance.

Sincerely,

Christine M. Cason
Christine M. Cason

CMC:mc
Enclosures

cc: Virginia S. Taylor, Esq.